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PETITIONS OFFICE

TO: \_\_\_\_\_ DATE: October 7, 2003  
COMPANY: United States Patent and Trademark Office  
FACSIMILE NO.: (703) 308-6916  
FROM: Richard J. Godlewski NO. OF PAGES 30  
(including this cover sheet).

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\*\*\*\*\*  
In Re Application of: Hartley et al.  
Atty. Docket No.: PA-5169-CON Group Art Unit: 3731  
Serial No.: 09/449,270 Examiner: Tan-Uyen T. Ho  
Filed: November 24, 1999  
Title: A PROSTHESIS AND A METHOD AND MEANS OF DEPLOYING A  
PROSTHESIS

Please enter and make of record the enclosed Petition To Withdraw The Holding of Abandonment Under 37 CFR 1.181 to application Serial No. 09/449,270. The following documents are enclosed with this transmission:

Transmittal of Petition To Withdraw The Holding of Abandonment Under  
37 CFR 1.181 (2 pages)

Petition to Withdraw The Holding of Abandonment Under 37 CFR 1.181  
(4 pages)

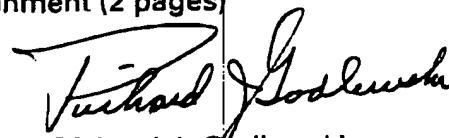
December 18, 2002, Final Office Action (7 pages)

March 28, 2003, Amendment and Response to Final Office action (8 pages)

April 8, 2003, Interview Summary (3 pages)

August 14, 2003, Advisory Action (3 pages)

October 3, 2003, Notice of Abandonment (2 pages)



Richard J. Godlewski  
Registration No. 30,056  
(812) 330-1824

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GROUP 3700

## CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

*October 7, 2003*

Date

*Paul Garwood*  
(Typed or printed name of person signing certification)

*Paul Garwood*

Signature

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Hartley et al.

Atty. Docket No.: PA-5169-CON

Customer No.: 9896

Serial No.: 09/449,270

Group Art Unit: 3731

Filed: November 24, 1999

Examiner: Uyen T. Ho

Title: A PROSTHESIS AND A METHOD AND MEANS OF DEPLOYING A  
PROSTHESIS

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COMMISSIONER FOR PATENTS  
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GROUP 3700

TRANSMITTAL OF PETITION TO WITHDRAW THE HOLDING  
OF ABANDONMENT UNDER 37 CFR 1.181

SIR:

Please make of record the following papers relating to the above-identified application:

Petition to Withdraw The Holding of Abandonment Under 37 CFR 1.181  
(4 pages)

December 18, 2002, Final Office Action (7 pages)

March 28, 2003, Amendment and Response to Final Office action (8 pages)

April 8, 2003, Interview Summary (3 pages)

August 14, 2003, Advisory Action (3 pages)

October 3, 2003, Notice of Abandonment (2 pages)

Serial No. 09/449,270

PATENT

No additional fee is required. In the event of improper payment of a required fee, the Commissioner is authorized to charge or to credit Deposit Account No. 13-2528 as required to correct the error.

Please address all correspondence to:

Richard J. Godlewski  
Patent Attorney  
P.O. Box 2269  
Bloomington, IN 47402-2269  
812-330-1824

Respectfully,

Date: Oct. 7, 2003

  
Richard J. Godlewski  
Attorney for Applicants  
Richard J. Godlewski  
Reg. No. 30,056

Page 2 of 2

<b>CERTIFICATION OF FACSIMILE TRANSMISSION</b>	
<p>I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being facsimile transmitted to the Patent and Trademark Office on the date shown below.</p>	
<u>October 7, 2003</u> <small>Date</small>	<u>Pamm Garwood</u> <small>(Typed or printed name of person signing certification)</small> <u>Pamm Garwood</u> <small>Signature</small>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In Re Application of:**

Hartley et al.

Atty. Docket No.: PA-5169-CON

Customer Number: 9896

Serial No.: 09/449,270

Group Art Unit: 3731

Filed: November 24, 1999

Examiner: Tan-Uyen T. Ho

**Title: A PROSTHESIS AND A METHOD AND MEANS OF DEPLOYING A PROSTHESIS**

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## PETITIONS OFFICE

SIRI

**PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT  
UNDER 37 CFR 1.181**

In response to the Advisory action, dated August 14, 2003, Paper No. 16, and the Notice of Abandonment, dated October 3, 2003, Paper No. 17, applicants petition and request the Commissioner under 37 CFR 1.181 to withdraw the abandonment of the application and the finality of the Office action, dated December 18, 2002, Paper No. 12. It is also requested that a new non-final Office action be sent to the applicants.

In support of this petition and request, applicants received the enclosed final Office action, dated December 18, 2002, Paper No. 12, in which claims 1-63 were pending and claims 12-17 and 43-63 were withdrawn from consideration. Claims 24-42 were allowed, and claims 1-11 and 18-23 were rejected. In response, applicants submitted the enclosed March 28, 2003, Amendment and Response, along with a Petition and Fee for a One Month Extension of Time. In the reply, the applicants traversed the Examiner's conclusion that applicants' previous amendment necessitated the new ground of rejection under 35 USC 112, second paragraph. This rejection was being raised for the first time by the Examiner in the final Office action of which the applicants' previously submitted amendment had no bearing or impact thereon. In view thereof, applicants submitted that making the action of December 18, 2002, final was improper, and it was requested that the finality of the December 18, 2002, Office action be withdrawn.

On April 7, 2003, Examiner Ho and applicants' attorney had a telephone interview in which an agreement was reached with respect to the claims. The Examiner withdrew the finality of the previous Office action and indicated that a new Office action would be sent to the applicants. The enclosed interview summary dated April 8, 2003, evidences such agreement and the action of Examiner Ho. As a result of this agreement, applicants' attorney understood that the finality of the Office action and the statutory six-month statutory period for reply had been withdrawn.

For sake of discussion, the six-month statutory period for reply to the December 18, 2002, final Office action expired on June 18, 2003. However after receipt of the interview summary, no communication was received from the Examiner by or on June 18, 2003.

On August 14, 2003, an Advisory action was mailed and received on August 18, 2003, in which the Examiner indicated that the March 28, 2003 reply filed by the applicants had failed to place the application in condition for allowance. As indicated in the enclosed Advisory action, the period to reply to the Advisory action expired on the mailing date of the Advisory action or the date set forth in the final rejection, whichever is later. Accordingly, as previously discussed, the

six-month statutory period for reply had expired on June 18, 2003, nearly two months prior to the mailing of the Advisory action. In addition, since the applicants did not receive the Advisory action until August 18, 2003, four days after the mailing date, the application was abandoned before the applicants received the Advisory action. The Examiner indicated that the proposed amendments of the March 28, 2003, reply raised new issues and would require further consideration and/or search. In addition, in the Note portion of the Advisory action, the Examiner indicated that after careful reconsideration of this application, the claim rejection under 35 USC 112 of the final Office action was withdrawn. Accordingly, the Examiner concluded that the finality of the previous Office action was proper.

Applicants strongly traverse such conclusion and submit that this is contrary to the April 7, 2003, interview summary in which the Examiner indicated the finality of the previous Office action was withdrawn and not just the withdrawal of the claim rejection under 35 USC 112, second paragraph. In addition, the Examiner indicated that a new Office action would be sent to the applicants. Applicants submit that the Examiner was at least obligated to notify applicants' attorney that she had changed her mind concerning the withdrawal of the final Office action before the expiration of the six-month statutory period for reply which expired on June 18, 2003, not two months afterward when the Advisory action was sent to the applicants' attorney. As a result of the Examiner's reversal of her written statement to withdraw the finality of the December 18, 2002 Office action, applicants have filed this petition and request under 37 CFR 1.181 to withdraw the holding of abandonment. This petition is being filed within two months of the August 14, 2003, Advisory action and the October 3, 2003, Notice of Abandonment as required under 37 CFR 1.181(f). As further required under 37 CFR 1.181(c), reexamination and reconsideration under 37 CFR 111 of this application was requested on page 5 of applicants' March 28, 2003, reply to the December 18, 2002, final Office action.

In view thereof, applicants request that the holding of abandonment of this application be withdrawn and that the finality of the December 18, 2002, Office

action be withdrawn and a new non-final Office action be sent to the applicants as indicated in the Examiner's interview summary of April 7, 2003.

Applicants submit this petition and request under 37 CFR 1.181, which does not indicate that a fee is required. However, should it be determined that payment of a fee is required for submittal of this petition and request, charge account 13-2528 for any such fee. Should this petition and request have been filed under another section of 37 CFR, this petition and request should be considered thereunder, and the payment of any necessary fee be charged to account 13-2528.

Respectfully submitted,

David Hartley  
Michael Lawrence Brown

Date: Oct 7, 2003

By   
Richard J. Godlewski, Attorney  
Reg. No. 30,056  
(812) 330-1824

Enclosures:

December 18, 2002, Final Office Action (7 pages)  
March 28, 2003, Amendment and Response to Final Office action (8 pages)  
April 8, 2003, Interview Summary (3 pages)  
August 14, 2003, Advisory Action (3 pages)  
October 3, 2003, Notice of Abandonment (2 pages)

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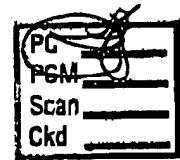
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United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,270	11/24/1999	DAVID HARTLEY	PA-5169-CON	6069
9896 7590	12/18/2002			
COOK GROUP PATENT OFFICE P.O. BOX 2269 BLOOMINGTON, IN 47402			EXAMINER	
			HO, UYEN T	
			ART UNIT	PAPER NUMBER
			3731	
			DATE MAILED: 12/18/2002	

*Leisal Dec 2/18/03*

Please find below and/or attached an Office communication concerning this application or proceeding.



DEC 23 2002 <b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/449,270	HARTLEY ET AL	
	Examiner (Jackie) Tan-Uyen T. Ho	Art Unit 3731	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 30 September 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-63 is/are pending in the application.

4a) Of the above claim(s) 12-17 and 43-63 is/are withdrawn from consideration.

5) Claim(s) 24-42 is/are allowed.

6) Claim(s) 1-11 and 18-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) Other.

<b>Notice of References Cited</b>		Application/Control No. 09/449,270	Applicant(s)/Patent Under Reexamination HARTLEY ET AL	
Examiner (Jackie) Tan-Uyen T. Ho		Art Unit 3731	Page 1 of 1	

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind	Code	Date MM-YYYY	Name	Classification
A	US-6,352,553		03-2002	van der Burg et al.	623/1.23
B	US-				
C	US-				
D	US-				
E	US-				
F	US-				
G	US-				
H	US-				
I	US-				
J	US-				
K	US-				
L	US-				
M	US-				

**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind	Code	Date MM-YYYY	Country	Name	Classification
N						
O						
P						
Q						
R						
S						
T						

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 and 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites the limitation "the longitudinal position" in lines 9-11 and claim 9 recites the limitation "the longitudinal and rotational position" in lines 7-8. There is insufficient antecedent basis for this limitation in the claims.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by van der Burg et al. (6,352,553).

In regard to claim 1, van der Burg et al. disclose an introducer for positioning an expandable prosthesis, the introducer including:

- A positioning mechanism releasable from the prosthesis (fig. 4A-4C)
- A first control member (306) separable from the positioning mechanism for retaining the prosthesis with the positioning mechanism and controlling at least a longitudinal position of the prosthesis
- A second control member (308) controlling at least the longitudinal position of the prosthesis

In regard to claims 2-4, wherein the positioning mechanism includes a distal attachment region having a distal attachment device (320) and a proximal attachment region having a proximal attachment device (321).

In regard to claims 6-7, wherein the positioning mechanism comprises an arrangement (318 and 324) for controlling the orientation of the prosthesis. Note: The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the van der Burg et al.'s positioning mechanism which is capable of being used as claimed if one desires to do so.

In regard to claim 8, wherein the introducer includes an expansion control mechanism (holes on the elements 320 and 321 holding the first control member 306 temporary) controlling expansion of the prosthesis.

***Allowable Subject Matter***

5. Claims 24-42 are allowed over the prior art. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest an introducer having proximal and distal attachment devices attaching to a prosthesis in such a manner that the prosthesis can be held in tension there between and each end of the prosthesis can individually be moved in proximal and distal directions and be rotated independent of the other and proximal releasing means associated with and separable from the proximal and distal attachment devices to enable selective releasing of the proximal and distal ends of the prosthesis.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3731

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703) 308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

(Jackie) Tan-Uyen T. Ho  
December 12, 2002

MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,270	11/24/1999	DAVID HARTLEY	PA-5169-CON	6069
9896 7590	04/08/2003			

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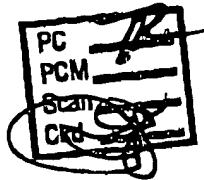
EXAMINER

HO, UYEN T

ART UNIT	PAPER NUMBER
3731	

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Interview Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/449,270	HARTLEY ET AL	
	Examiner (Jackie) Tan-Uyen T. Ho	Art Unit 3731	

All participants (applicant, applicant's representative, PTO personnel):

(1) Jackie Tan-Uyen T. Ho (3) \_\_\_\_\_

(2) Richard Godlewski (4) \_\_\_\_\_

Date of Interview: 07 April 2003

Type: a) Telephonic b) Video Conference  
c) Personal [copy given to: 1) applicant 2) applicant's representative]

Exhibit shown or demonstration conducted: d) Yes e) No.

If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: \_\_\_\_\_

Identification of prior art discussed: \_\_\_\_\_

Agreement with respect to the claims f) was reached. g) was not reached. h) N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: the finality of the previous office action is withdrawn and a new office action will be send to the applicant shortly .

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

*4/7/03*  
*Jackie Tan*  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to, include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner.  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

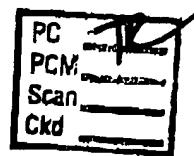
If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,270	11/24/1999	DAVID HARTLEY	PA-5169-CON	6069
9896	7590	08/14/2003		
COOK GROUP PATENT OFFICE P.O. BOX 2269 BLOOMINGTON, IN 47402			EXAMINER	
			HO, UYEN T	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 08/14/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.



**RECEIVED****Advisory Action**

Application No.	Applicant(s)	
09/449,270	HARTLEY ET AL.	
Examiner (Jackie) Tan-Uyen T. Ho	Art Unit 3731	

*--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

THE REPLY FILED 28 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 9-42.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-8.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8.  The proposed drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.

9.  Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.

10.  Other: \_\_\_\_\_.

**MICHAEL J. MILANO**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**

Continuation of 2. NOTE: After careful reconsideration of this application, the claim rejection under 35 USC 112 of previous office action is withdrawn. Therefore, the final action made in previous office action is proper. Applicants argue that there "should not require any further consideration or searching on the part of the Examiner" because the newly added limitation of claim 1 was discussed and included in independent claim 9. Examiner respectfully disagrees with the applicants' argument. Although, the newly added limitation of claim 1 is a subject matter included in claim 9, it does not mean that allowing claim 9 would place claim 1 in condition for allowance. The newly added limitation of claim 1 raise new issues that would require further consideration and/or search because claim 1 is broader than claim 9.

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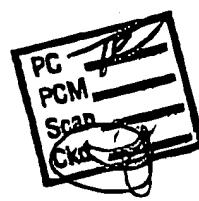
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,270	11/24/1999	DAVID HARTLEY	PA-5169-CON	6069
9896 7590	10/03/2003		EXAMINER	HO, UYEN T
COOK GROUP PATENT OFFICE P.O. BOX 2269 BLOOMINGTON, IN 47402			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



**Notice of Abandonment**

Application No.

09/449,270

Examiner

(Jackie) Tan-Uyen T. Ho

Applicant(s)

HARTLEY ET AL.

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1.  Applicant's failure to timely file a proper reply to the Office letter mailed on 8/14/2003.
  - (a)  A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b)  A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c)  A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d)  No reply has been received.
2.  Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a)  The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b)  The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c)  The issue fee and publication fee, if applicable, has not been received.
3.  Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a)  Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b)  No corrected drawings have been received.
4.  The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5.  The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6.  The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7.  The reason(s) below:

MICHAEL J. MILANO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

4. Calculation of extension fee (37 CFR 1.17(a)-(d)):

Extension (months)	Fee for other than small entity	Fee for small entity
[ x ] one month	\$ 110.00	\$ 55.00
[ ] two months	\$ 400.00	\$200.00
[ ] three months	\$ 920.00	\$460.00
[ ] four months	\$1,440.00	\$720.00
		Fee \$ <u>110.00</u>

If an additional extension of time is required, please consider this a petition therefor.

*(Check and complete the next item, if applicable)*

[ ] An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ 110.00

5. Extended period for response

Based on the extension requested in this petition (and that for which a previous petition has been filed, if any), the extended period for response will expire on April 18, 2003.  
(date)

6. Fee Payment

[ ] Charge Account 13-2528 for any additional extension and/or fee required or credit for any excess fee paid.

[X] Charge fee to Account No. 13-2528. This is a request to charge for any additional extension and/or fee required or credit for any excess fee paid.

Date March 28, 2003

  
Richard J. Godlewski  
SIGNATURE OF ATTORNEY/AGENT

Reg. No. 30,056

Richard J. Godlewski

Tel. No.: (812) 330-1824

P.O. Box 2269

Bloomington, IN 47402-2269

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Hartley et al.

Atty. Docket No.: PA-5169-CON

Serial No.: 09/449,270

Group Art Unit: 3731

Filed: November 24, 1999

Examiner: Uyen T. Ho

Title: A PROSTHESIS AND A METHOD AND MEANS OF DEPLOYING A PROSTHESIS

Commissioner for Patents  
Washington, D.C. 20231

## PETITION AND FEE FOR EXTENSION OF TIME (37 CFR 1.136(a))

1. This is a petition for an extension of the time for a total period of one month to respond to the Final Office Action dated December 18, 2002  
 (INDICATE MATTER BEING EXTENDED)

2. A response in connection with the matter for which this extension is requested:

is filed herewith.

has been filed.

The response is the filing of a continuation application having an express abandonment conditioned on the granting of a filing date to the continuing application.

3. Applicant is other than a small entity.

## CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8a)

I hereby certify that this correspondence is, on the date shown below, being:

## MAILING

deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Washington, DC 20231.

## FACSIMILE

transmitted by facsimile to the Patent and Trademark Office

Kay Strahm  
Signature

Date: March 28, 2003

Kay Strahm  
(Type or print name of person certifying)

(Petition and Fee for Extension of Time (37 CFR 1.136(a) [11-2] -- page 1 of 2)

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